

REMARKS

Claims 39-46 are pending in the application.

Claims 39-45 have been rejected.

Claim 46 has been objected to.

Claims 39, 42 and 44 have been amended, as set forth herein.

II. **REJECTION UNDER 35 U.S.C. § 103**

Claims 39, 40, 42 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shirai (US 6,104,924) in view of Gauvin, et al. (US 5,991,760). Claim 41 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shirai (US 6,104,924) in view of Gauvin, et al. (US 5,991,760) and further in view of Spaur, et al. (US 5,732,074). Claim 45 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shirai (US 6,104,924) in view of Gauvin, et al. (US 5,991,760) and further in view of Perdomo (6,118,995). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of

obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to independent Claims 39, 42 and 44, the Office Action argues that Shirai discloses a memory in a wireless terminal which, in an on-line mode, is adapted to be treated as a local virtual memory by an application program running on a server (citing from Shirai that “fixed station supplies to the mobile station the appropriate scripts which the mobile station is

capable of utilizing, the mobile station stores the supplied scripts in its memory”, col. 5, lines 5-9). See, Office Action, page 2. Thus, the Office Action asserts that downloading scripts from a fixed station to mobile station and storing the scripts within the mobile station is apparently equivalent to Applicant’s providing a memory on a wireless terminal which, when in an on-line mode, is adapted to be treated as a local virtual memory by an application program running on a server and to read and write data in the virtual memory related to the application program (running on the server). In one aspect, Applicant’s invention allows the wireless terminal user to access data (e.g., a list of data items) associated with particular software program running on a server, without typically having to initiate and establish a communications link to the server (from the wireless terminal) to download the data from the server. This is because the data is already stored locally in the virtual memory of the wireless terminal. See, Specification, page 13, lines 9-24. In contrast, in the prior art systems, when the user desired to access data related to the software program running on the server, the user first needed to initiate and establish a communications link with the server to access the data. See, Specification, page 13, lines 3-8.

The Shirai reference, on the other hand, provides that a mobile station operates as a virtual terminal of the fixed station as defined by the SMS-VT protocol which uses SMS text messaging. Thus SMS-VT protocol’s primary function is to transmit information from a fixed station to a mobile station so as to define the user interface of that mobile station. Col. 2, lines 57-65. Shirai does not appear to recite that the software application running on the server treats memory in the

wireless terminal as virtual local memory in an on-line mode (when there exists a session over an active link between the wireless terminal and the server).

Applicant has amended independent Claims 39, 42 and 44 to recite the (1) on-line mode occurring when there exists a session over an active link between the wireless terminal and the server, and (2) off-line mode occurring when there does not exist a session over an active link between the wireless terminal and the server. Thus, Applicant provides memory in the wireless terminal that is treated as local virtual memory by the application program running on the server when in the on-line mode (when there exists a session over an active link between the wireless terminal and the server) to read and write data related to the application program. Shirai does not disclose, recite or suggest such feature/element.

In addition, the Office Action concedes that Shirai does not disclose “. . . wherein in the off-line mode, when the application program running on the server modifies data at the server, the application program running on the server establishes a data connection with the wireless terminal and updates corresponding data in the virtual memory . . .” See, Office Action, p. 3. The Examiner argues that Gauvin teaches this element. See, Office Action, p. 3 (citing abstract; Col. 2, lines 11-29; Col. 5, lines 6-40 and 54-57). To the contrary, Gauvin recites downloading a copy of a document (database) from an origin server to a local computer, modifying the document (database), and updating the document (database) at the server upon re-connection of the local computer to the server. The Office Action appears to interpret the server and local computer of Gauvin as Applicant’s server and wireless terminal. In such a case, Gauvin would

likely only teach (1) downloading of data from the server to the wireless terminal, (2) off-line modification of the downloaded data at the wireless terminal when the terminal is disconnected from the server, and (3) reconnecting the terminal to the server to upload the modified data to the server to change the original data. Applicant's claims recite modification of the data at the server (not modification of the data at the terminal, as recited by Gauvin) and thereafter establishing a connection from the server to the terminal to update the data in the virtual memory of the terminal (not updating data in the server, as recited by Gauvin). In addition to this particular element/feature, Applicant's claims also recite local application program modification of the data stored at the terminal and initiating a session with the server to output the updates to the server. Also, neither Shirai or Gauvin disclose, teach or suggest that when the server data is modified (added, modified, deleted), the server application program thereafter initiates and establishes a session with the terminal to update the data at the terminal.

Thus, none of the references, either alone or in combination teach or suggest all the claim elements/features. Moreover, there is no suggestion or motivation in the references themselves to modify either reference or to combine reference teachings.

Accordingly, Applicants respectfully request withdrawal of the § 103 rejection of Claims 39-45.¹

¹ For these same reasons, none of the references render obvious Claims 41 and 45.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@davismunck.com*